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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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James Harold Gray

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AT&T Legal Department

Attn: Patent Docketing

Room 2A-207

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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT

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2421

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,309	Applicant(s) GRAY ET AL.	
	Examiner DOMINIC D. SALTARELLI	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 5, 2008 has been entered.

Response to Arguments

2. Applicant's arguments filed December 5, 2008 have been fully considered but they are not persuasive.

Applicant argues that the combination of Gudorf and Youden fail to disclose the claim limitations of "determining whether the first user command is an automatic function that is automatically locally stored in memory of the viewer appliance." and "performing a look-up when the first user command is not the automatic function" and "determining, in response to the look-up, whether the first user command is to be locally stored in the memory of the viewer appliance and remotely stored at a network location.", citing the fact the neither Gudorf nor Youden individually teach the feature of making the decision regarding where to store a command.

The examiner first must note that the amended limitations "determining whether the first user command is an automatic function that is automatically locally stored in

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memory of the viewer appliance." and "performing a look-up when the first user command is not the automatic function" are not supported by the originally filed specification, as described below regarding the 35 USC 112 first paragraph rejections applied to each of the independent claims which recite this feature.

Second, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner has provided in the rejections the rationale regarding the types of modifications a person of ordinary skill in the art would make to Gudorf when modifying his invention to include the type of video on demand system disclosed by Youden and how they would meet the claimed limitations of applicant's invention. The rejected claims go no further than deciding whether to store a received command locally or to send and store the command remotely, which is not patentably distinct in view of the prior art.

Claim Rejections - 35 USC § 112

3. Claims 1-28 and 32-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 14, 23, 28, and 32 each recite the limitations of first determining whether the first user command is an automatic function that is automatically stored in memory of the viewer appliance and then performing a look-up when the first user command is not the automatic function. In each instance found in the specification, the decision by the viewer appliance is to either use a look-up table **or** have it be an automatic function of the user command, see for example, page 17, lines 11-13, page 17, lines 21-24, and page 18, lines 18-20. In every instance, the query in question is either one or the other, but never both. The claims will be interpreted in light of the specification to mean either performing the determining step or performing a look-up, as enabled by the specification.

Consequently, claims 2-13, 15-22, 24-27, and 33-38, which each in turn depend on one of claims 1, 14, 23, 28, and 32 are also rejected as failing to comply with the enablement requirement.

Further, claim 35 recites determining if a first subscriber command is not to be stored locally, then forwarding the second subscriber command from the device. There is no support in the specification for using the determination related to a first command to control where a second command is stored or executed. The examiner will interpret the claim in light of the specification and assume the applicant intended to state that if a *second* subscriber command is not to be stored locally, then forwarding the second subscriber command from the device.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 11, 12, 13, 23-29, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Swix et al. (6,718,551, provided by applicant on 12/5/2008) [Swix]

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-6, 8, 9, 11, 12, 23-29, and 32-36, Swix discloses a method and system for capturing user commands from a viewer that are related to viewing content (col. 3, lines 25-47), comprising:

receiving a first subscriber command (at a set top box, col. 6, lines 39-59) having an application identifier corresponding to a particular application to which the first subscriber command is addressed (col. 3, lines 56-64);

performing a look-up to determine if the first subscriber command is to be locally stored in a media device (the system determines whether the session is

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an interactive one where commands are remotely stored at the file server 102 or a broadcast session where commands are locally stored and uploaded at a later time, which could be predetermined intervals, col. 8, lines 14-45);

when the first subscriber command is to be locally stored, then capturing and locally storing the first subscriber command along with i) the application identifier, ii) an identification code corresponding to the first subscriber command, and iii) a time stamp that records a time of occurrence of the first subscriber command and locally executing the first subscriber command at the media device (col. 3, lines 56-64); and

when the first subscriber command is not to be locally stored, then forwarding the first subscriber command to a remote network location (file server 102 when the session is an interactive one, step 204a in fig. 2);

subsequently receiving a second subscriber command at the media device and concurrently storing information related to the second command at the media device or forwarding the second subscriber command from the media device to a component remotely located from the media device (the above steps are performed for each command, col. 8, lines 46-54);

wherein the first and second user commands are executed at the media device to alter aspects of the content being viewed by the viewer (col. 3, lines 56-61).

Regarding claims 7 and 37, Swix discloses the method of claims 1 and 32, further comprising receiving a second user command and determining a result for the second user command relative to a present context and including the result in the information related to the second user command that is forwarded from the viewer appliance (events included not only content viewed, but content not viewed as well, such as which commercials a viewer actively turned off, col. 12, lines 20-36).

Regarding claim 13, Swix discloses the method of claim 1, further comprising receiving targeted advertising based upon the information related to the user command (col. 5, lines 29-33).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13, 23-29, and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudorf et al. (US 2003/0110489 A1, of record) [Gudorf] in view of Youden et al. (5,606,359, of record) [Youden].

Regarding claims 1-6, 9, 23, 24, 27, 28, and 29, Gudorf discloses a method and system for capturing user commands from a viewer that are related to viewing content (figs. 1 and 2), comprising:

locally storing user commands which alter aspects of the content viewed by the viewer in the viewer appliance (paragraph 0022);

relative to receiving the commands, concurrently storing information related to the user commands at the viewer appliance, the information related to the user commands including a date and time of receipt (clickstream commands are time stamped, paragraph 0022); and

executing the user commands at the viewer appliance to alter aspects of the content being viewed by the viewer while the information related to the commands continues to be stored at the viewer appliance (commands include channel change and volume change commands, paragraphs 0022-0024).

Gudorf fails to disclose performing a look-up to determine whether the user commands are to be locally stored in the viewer appliance and remotely stored at a network location, and remotely storing the first user command at the network location when remote storage is determined.

In an analogous art, Youden teaches providing interactive, on-demand programming to users from a remote location, requiring those commands which control said programming to be sent to the remote location (col. 10 line 34 - col. 11 line 3 and col. 13 line 65 - col. 14 line 26), providing the benefit of video on demand services (col. 1, lines 10-26).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Gudorf to include interactive, on-demand programming to users from a remote location, requiring those commands which control said programming to be sent to the remote location, as taught by Youden, for the benefit or providing video on demand services, a service known to be desired by broadcast customers. Since the commands which define the clickstream for video on demand applications must be sent upstream (such as the request itself, and VCR style commands), a determination must be performed to decide where the commands are to be stored, since for example, a request to fast forward a video on demand program from a remote location would be meaningless to the receiver alone, and must be sent upstream to the remote location.

Regarding claim 7, Gudorf and Youden disclose the method of claim 1, further comprising receiving a second user command and determining a result of the second user command relative to a present context and including the result in the information related to the second user command that is forwarded from the viewer appliance (commands include relative changes in volume and channel changes, Gudorf, paragraph 0024).

Regarding claims 8, 10, 25, and 26, Gudorf and Youden disclose the method and system of claims 1, 9, and 23, wherein the commands are received at a set-top box integrated with a television (Gudorf, paragraph 0017).

Regarding claims 11-13, Gudorf, Youden, and Hasselberg disclose the method of claim 1, and further disclose forwarding the information related to the user commands after a pre-determined period of time from the viewer appliance to a remote location where it is used for targeted advertising (Gudorf, paragraph 26, lines 1-4).

Regarding claim 32, Gudorf discloses a method of collecting subscriber commands related to viewing content, comprising:

receiving a first subscriber command and concurrently locally storing an event record at a media device, the event record comprising an identification code corresponding to the first subscriber command, and a time stamp that records a time of occurrence of the first subscriber command (paragraph 0022).

Gudorf fails to disclose performing a look-up to determine whether the first subscriber command is to be locally stored at the media device or remotely stored at a network location and the first subscriber command has an application identifier corresponding to a particular application to which the first subscriber command is addressed, wherein the event record includes the application identifier, and subsequently receiving a second subscriber command at the

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media device and concurrently forwarding the second subscriber command from the media device to a component remotely located from the media device.

In an analogous art, Youden teaches providing interactive, on-demand programming to users from a remote location, requiring those commands which control said programming to be sent to the remote location (col. 10 line 34 - col. 11 line 3 and col. 13 line 65 - col. 14 line 26), providing the benefit of video on demand services (col. 1, lines 10-26).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Gudorf to include interactive, on-demand programming to users from a remote location, requiring those commands which control said programming to be sent to the remote location, as taught by Youden, for the benefit or providing video on demand services, a service known to be desired by broadcast customers. Since the commands which define the clickstream for video on demand applications are destined for the video on demand server rather than for controlling the local tuner (Youden, col.10, lines 34-45 and col. 10 line 67 - col. 11 line 3), tracking this activity requires adding an application identifier to the command and the event record, as desired by Gudorf (who teaches tracking the specifics what a user watches and does to determine viewing habits, paragraph 0024). Further, those commands specific to the video on demand application correspond to the claimed second command which is forwarded to a remote component, as the commands are sent upstream to a real time controller (Youden, real time controller 60, fig. 2).

Regarding claim 33, Gudorf and Youden disclose the method of claim 32, wherein the method comprises performing a look-up to determine whether the second subscriber command is to be locally stored at the media device or remotely stored at a network location, since the commands which define the clickstream for video on demand applications must be sent upstream (such as the request itself, and VCR style commands), a determination must be performed to decided where the commands are to be stored, since for example, a request to fast forward a video on demand program from a remote location would be meaningless to the receiver alone, and must be sent upstream to the remote location.

Regarding claims 34 and 35, Gudorf and Youden disclose the method of claim 33, wherein when the first or second subscriber command is to be remotely stored at the network location (that is, not to be stored locally), then the first or second subscriber command, respectively, is forwarded from the device to the network location (when the command relates to video on demand applications, they are sent upstream, Youden, col. 10, lines 34-45 and col. 10 line 66 - col. 11 line 3).

Regarding claim 36, Gudorf and Youden disclose the method of claim 32, and further disclose forwarding the information related to the user commands

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after a pre-determined period of time from the media device (Gudorf, paragraph 26, lines 1-4).

Regarding claims 37 and 38, Gudorf and Youden disclose the method of claim 32, further comprising receiving a second user command and determining a result of the second user command relative to a present context and including the result in the information related to the second user command that is forwarded from the media device (commands include relative changes in volume and channel changes, Gudorf, paragraph 0024).

Allowable Subject Matter

8. Claims 14-22 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter: Independent claim 14 describes a stepwise and patentably distinct invention which involves an intelligent system that decides which commands to store and where to store them in a more complex manner than the simple binary approach of whether or not to store a command locally.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is

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(571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dominic D Saltarelli/
Examiner, Art Unit 2421